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REMARKS**ALLOWABLE CLAIMS 15-16**

Applicant thanks the Examiner for the indicated allowability of claims 15 and 16. It is not believed to be necessary to amend claim 15 in independent form at this time, as it is submitted *infra* that the rejections of these base claims are improper.

OBJECTION AND 35 U.S.C. § 112 REJECTION OVER INCORPORATED MATTER

The Examiner stated that the incorporation by reference of subject matter pertaining to 49 C.F.R. § 180, DOT 12095, Rule 88.B.2, etc. into the application is improper.

Claims 1, 4-17 and 20 were rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter not described in the specification in such a manner as to convey to one of ordinary skill in the art that the inventor had possession of the claimed invention at the time the application was filed. The Examiner again referred to the limitations 49 C.F.R. § 180, DOT 12095, AAR CPC-1094 and Rule 88.B.2 as being "essential material" which may not be incorporated by reference.

In view of the Examiner's objection and rejection over the improper incorporation of the subject matter of 49 C.F.R. § 180.509, DOT 12095, AAR CPC-1094 and Rule 88.B.2, substantively complete portions thereof are hereby bodily incorporated into the specification in accord with the amendments presented herein. Such incorporation does not constitute an admission that any or all of the incorporated material is itself deemed "essential material" by Applicants, as opposed to "non-essential material" (which may be incorporated by reference), as

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such measures were taken as an expedient to prosecution rather than a laborious comparison of each aspect of the Applicant's disclosure to each aspect of the incorporated materials to identify where, if at all, essential material may have indeed been improperly incorporated by reference. In other words, the present incorporation is intended merely as a prophylactic measure to protect against any inadvertent omissions in the original disclosure, which already embodies substantive portions of 49 C.F.R. § 180, DOT 12095, AAR CPC-1094 and Rule 88.B.2.

To the extent that the amendatory material may, in fact, contain any essential material not already present within the original disclosure, MPEP 608.01(p) states that "[t]he filing date of any application wherein essential material is improperly incorporated by reference to a . . . publication will not be affected because of the reference". Instead, "the applicant will be required to amend the specification to include the material incorporated by reference." Such amendment "must be accompanied by an affidavit or declaration executed by the applicant, or a practitioner representing the applicant, stating that the amendatory material consists of the same material incorporated by reference in the referencing application". Attached hereto is a Declaration under 37 C.F.R. § 1.132 executed by William D. Pegg (Reg. No. 42,988), a practitioner representing the applicant (see, e.g., MPEP 608.01(p), MPEP 716, and Power of Attorney filed on April 4, 2001), attesting that the amendatory material consists of the same material incorporated by reference in the referencing application.

Withdrawal of both the objection and 35 U.S.C. § 112, first paragraph rejection of claims 1, 4-17 and 20, directed to the material previously incorporated by reference is requested.

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OBJECTION OF CLAIMS 1 AND 17

Claims 1 and 17 were objected to for referencing the acronym SSIP without spelling it out. Claims 1 and 17 are hereby amended to spell out the acronym as "Stub Sill Inspection Program" to overcome this objection. Claim 20 was also objected to for the use of the term "accord", whereas the Examiner expresses a preference for the term "accordance". Claim 20 is amended to comply with the Examiner's expressed preference and withdrawal of this objection is requested.

35 U.S.C. § 103 REJECTIONS OVER McCASLAND AND DUNN

Claims 1 and 17 are being rejected under 35 U.S.C. § 103(a) as being unpatentable over McCasland (U.S. Patent No. 5,856,931) in view of Dunn (Paper titled "Integrating RCM with Effective Planning and Scheduling - Part 1"). Claims 4-14 and 20 are being rejected under 35 U.S.C. § 103(a) as being unpatentable over McCasland in view of Dunn and 49 C.F.R. § 180.509. These rejections are traversed.

McCasland is alleged to disclose an inspection method and system for, *inter alia*, railroad tanker cars (col. 3, lines 3-4) employing a reliability centered maintenance (RCM) analysis which predicts optimum maintenance task intervals based on continually updated past performance and failure. McCasland is acknowledged not to disclose or suggest "aligning various inspection requirements" and Dunn is therefore relied upon for this teaching.

It is submitted that McCasland's teaching of an optimized "inspection route" or list of specific inspection points by asset (citing col. 3, lines 39-42) is not "substantially equivalent to" the claimed step of "inspecting each of the listed sites in accord with the instructions set forth for

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each of the listed sites in the instruction set", which list of sites relates to the claim step of "selecting from an instruction set comprising inspection sites covered by 49 C.F.R. § 180.509, SSIP, and Rule 88.B.2, a comprehensive list of sites to be inspected for the selected type of vehicle". In order to rely on equivalence as a rationale supporting an obviousness rejection, the equivalency must be recognized in the prior art, and cannot be based on applicant's disclosure or the mere fact that the components at issue may be functional or mechanical equivalents. *In re Ruff*, 256 F.2d 590 (CCPA 1958).

Moreover, **Dunn** has not been shown to constitute "prior art". **Dunn** states that "This paper was presented to the West Australian Optimizing Maintenance Conference, in Australia on 14 May 1999", but Page 5/5 thereof states "Copyright 2002, The Plant Maintenance Resource Center . . . Revised: Wednesday, 18-Sep-2002 03:11:34 CDT". Although the paper was "presented" in another country, it is not clear if the subject matter of the cited **Dunn** reference was, in fact, "described in a printed publication in . . . a foreign country". A paper which is orally presented in a forum open to all interested persons constitutes a "printed publication" if written copies are disseminated without restriction. See *Massachusetts Institute of Technology v. AB Fortia*, 774 F.2d 1104, 1109 (Fed. Cir. 1985). In this case, the Examiner has not discharged the burden of establishing **Dunn** was, in fact, disseminated and would therefore constitute a "printed publication" available for use in a 35 U.S.C. § 103 rejection.

Additionally, the Examiner has not established that **Dunn** was "known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for patent" (35 U.S.C. § 102(a)) or that "the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application for

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patent in the United States" (i.e., Oct. 1, 1998)(35 U.S.C. § 102(b)). Prior art disclosures on the Internet or on an on-line database are considered to be publicly available as of the date the item was publicly posted. The Examiner has provided no evidence showing that the **Dunn** reference should be afforded a publication date earlier than September 18, 2002. Accordingly, **Dunn** has not been shown to qualify as prior art via 35 U.S.C. §§ 102(a)-102(b).

At best, **Dunn** could be argued to reflect a general knowledge in the art at the time of the conference (May 14, 1999). Since the conference was not in the United States, however, the knowledge relied upon by the Examiner has not been shown to be relevant to obviousness under 35 U.S.C. § 103(a) as the knowledge relied upon must be knowledge or use "in this country." *See, e.g., In re Ekenstam*, 256 F.2d 321, 118 USPQ 349 (CCPA 1958)(*see also* MPEP § 2141.01, discussing relation of 35 U.S.C. § 102 and 103 rejections and availability of references as prior art).

In view of the above failure of the Examiner to demonstrate that **Dunn** constitutes prior , it is submitted that both of the 35 U.S.C. § 103 rejections set forth by the Examiner, each of which is premised upon **Dunn**, are improper and should be withdrawn.

Allowance of all pending claims is solicited. "If examination at the initial stage does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of the patent." *In re Oetiker* 24 USPQ2d 1443, 1444 (Fed. Cir. 1992)(*citations omitted*).

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper,

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including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

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